

wherein the ink is in the form of a W/O emulsion in which the content of the oil phase is 20 to 40% by weight of the total weight of the ink and the content of the water phase is 60 to 80% by weight of the total weight of the ink.

### REMARKS

The Office Action of February 7, 2002 was received and carefully reviewed. As a result, reconsideration and withdrawal of the currently pending rejections are requested for the reasons advanced in detail below.

Claims 1-5 were pending prior to the instant amendment. By the above amendments, claims 1-5 have been canceled, and new claims 6-25 added with claim 6, 11, 18 and 25 being independent; consequently, claims 6-25 remain pending in the instant application. Please note that the specification, at page 6, line 1, contained a typographical error in reciting "0.1 to 1%" rather than "0.01 to 1%" as set forth in original claim 4 and Table 1, Examples 1 and 4.

The Examiner's sets forth the following rejections:

1) Claims 1-5, under 35 U.S.C. 102(e), as being anticipated by the teachings of either Asada ('258) or Okuda ('444),

2) Claims 1-5, under 35 U.S.C. 102(b), as being anticipated by the teachings of Ono et al ('151),

3) Claims 1-5, under 35 U.S.C. 102(e), as being anticipated by the teachings of Ohshima et al ('835),

4) Claims 1 and 4, under 35 U.S.C. 102(b), as being anticipated by the teachings of Ono et al ('815),

5) Claims 1, 4 and 5, under 35 U.S.C. 102(b), as being anticipated by the teachings of JP ('401),

6) Claims 2-3, under 35 U.S.C. 103(a), as being obvious in view of the teachings of Ohshima

et al ('835), Ono et al ('815), or JP ('401) in combination with the teachings of Asada ('258), at pages 2-6, of the Office Action.

In response to each of these rejections, the Applicant has amended the claims by canceling claims 1-5 in favor of independent claims 6, 11, 18 and 25, as well as dependent claims 7-10, 12-17 and 19-24, in which claim 6 requires an:

"an alkyl-modified carboxyvinyl polymer and/or carboxyvinyl polymer in which the content of the alkyl-modified carboxyvinyl polymer and/or carboxyvinyl polymer is 0.2 to 0.4% by weight of the total weight of the ink, and borax" (emphasis added)

while, claim 11 requires an:

"an alkyl-modified carboxyvinyl polymer in which the content of the alkyl-modified carboxyvinyl polymer is 0.01 to 1% by weight of the total weight of the ink, and borax" (emphasis added)

and claim 18 requires an:

"alkyl-modified carboxyvinyl polymer and carboxyvinyl polymer in which the content of the alkyl-modified carboxyvinyl polymer and the carboxyvinyl polymer is 0.01 to 1% by weight of the total weight of the ink, and borax" (emphasis added).

Claim 25 is a combination of the features of claims 11 and 18 with dependent claims 14 and 15 (or claims 21 and 22).

Further, a review of the Asada ('258), Okuda ('444), Ono et al ('151), Ohshima et al ('835), Ono et al ('815), or JP ('401) references reveals that none of the references disclose each and every feature of the presently claimed ink composition as required for anticipation under 35 U.S.C. 102(b), and MPEP Chapter 2131. Additionally, none of the references set forth a suggestion or motivation to combine the individual components from each of the references to achieve the ink composition of claims 6, 11, 18 or 25 in the amounts particularly specified.

Specifically, with regard to the Asada ('258), Okuda ('444) and Ono et al ('151) references,

none of these references teach the concentration of the alkyl-modified carboxyvinyl polymer and/or carboxyvinyl polymer is 0.2 to 0.4% by weight of the total weight of the ink of claim 6. Further, neither the Asada ('258) or Okuda ('444) references teach the use of an "alkyl-modified carboxyvinyl polymer" of claim 11 (and claim 25) or an "alkyl-modified carboxyvinyl polymer and carboxyvinyl polymer" of claim 18 (and claim 25). Note also, that Ono et al ('151) and Okuda et al ('444) teach not to use water soluble resins in amounts less than 1% (see column 3, lines 1-5 of Ono et al and column 4, lines 19-27).

In addition, with regard to the Okuda ('444) reference applied by the Examiner, the Applicant notes that the instant application and the Okuda ('444) reference were/are commonly owned at the time of the invention by the same assignee, Riso Kagaku Corporation. Therefore, pursuant to Official Gazette Notice, 1241 OG 96 (Dec. 26, 2000), it is hereby stated that the instant application and the Okuda ('444) reference were, at the time the invention was made, owned by, or subject to an obligation of assignment to, the same person. This statement is sufficient to remove the Okuda ('444) as a reference in any rejection under 35 U.S.C. 102(e)/103(c), see MPEP Chapter 706.02(I).

Additionally, with regard to the Ohshima et al ('835), Ono et al ('815), or JP ('401) references, each fails to teach each and every feature of the presently claimed invention. For example, none of these references teach the use of borax in the disclosed ink compositions as set forth in independent claims 6, 11, 18 and 25. Further, neither the Ohshima et al ('835), Ono et al ('815), or JP ('401) references teach the use of an "alkyl-modified carboxyvinyl polymer" of claim 11 (and claim 25) or an "alkyl-modified carboxyvinyl polymer and carboxyvinyl polymer" of claim 18 (and claim 25).

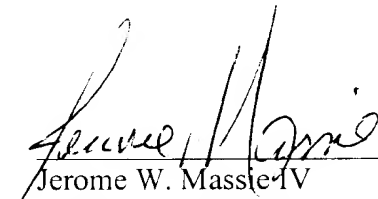
Therefore, since none of the references cited by the Examiner teaches each and every feature of the present claims 6-25, as is required for anticipation under 35 U.S.C. 102(b) and MPEP Chapter 2131, and since none the references (or the Examiner) provide a suggestion for combining the features of the references to achieve the specifically claimed features of the present invention, as is required for a prima facie case of obviousness, under 35 U.S.C. 103(a) and MPEP Chapter 2143, the rejections of claims 1-5 (now claims 6-25) under 35 U.S.C. 102(e), under 35 U.S.C. 102(b) or 35

rejections of claims 1-5 (now claims 6-25) under 35 U.S.C. 102(e), under 35 U.S.C. 102(b) or 35 U.S.C. 103(a) are believed to be improper and must be withdrawn.

In view of the foregoing, the present application should now be in condition for allowance and a notice to that effect is respectfully requested. However, if the Examiner finds any issue to remain unresolved after considering this response, or should any new issue arise, she/he is invited to call the undersigned to expedite the prosecution by working out any such issue by telephone.

Lastly, it is noted that a separate Petition for Extension of Time (one month) accompanies this response along with a check in payment of the requisite extension of time fee. However, should that petition become separated from this Amendment, then this Amendment should be construed as containing such a petition. Likewise, any overage or shortage in the required payment should be applied to Deposit Account No. 19-2380 (740250-827).

Respectfully submitted,

  
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